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10/544,151	08/01/2005	Francis X. Smith	3009108 US01	6429
44331 7590 04/13/2011 HISCOCK & BARCLAY, LLP 2000 HSBC PLAZA 100 Chestnut Street ROCHESTER, NY 14604-2404				
EXAMINER				
FAY, ZOHREH A				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/544,151
Filing Date: August 01, 2005
Appellant(s): SMITH, FRANCIS X.

Jason R. Womer
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 29, 2010 appealing from the Office action mailed June 29, 2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-4 and 6-11.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

6,139,646 Asgharian et al. 10-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4 and 6-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asgharian et al. (US Patent 6,139,646).

Asgharian et al. teach a contact lens solution of a cationic polymeric preservative and a preservative enhancer of glycerin, sorbitol and a propylene glycol. See column 7, lines 15-33, column 10, lines 19-67 and example 2. The use of chloride at the concentrations of less than 0.2 is taught in column 8, lines 32-33. The use of a buffer such as borate is taught in column 7, lines 35 and 36. The use of a sequestering agent such as EDTA is taught in column 11, lines 48-50. The use of a simple saccharide is taught in column 14, example 4. The above reference differs from the claimed invention in being effective as a single part composition. It would have been obvious to a person skilled in the art to use the claimed components in a single composition, considering that the prior art, also has all the components of the claimed invention in a single part before being mixed with the enzymic solution.

(10) Response to Argument

Appellant's arguments and remarks have been carefully considered, but are not deemed to be persuasive. Appellant in his remarks argues that Asgharian's teachings are related to a liquid enzyme composition for cleaning a contact lens. Appellant goes

on by saying that this enzyme composition would not be suitable for direct eye contact, as enzyme solutions are known to those skilled in the art to be harmful to the eye. The arguments have been noted. The examiner directs appellant's attention to column 9, lines 60-65 of Asgharian et al., which teaches the composition will be physiologically acceptable to the eye. Furthermore, Asgharian's composition is employed in a two-compartment bottle assembly, which uses the enzyme solution in one compartment and the disinfecting composition in another compartment, which can be mixed before usage. Therefore, the use of the claimed components is taught in part II, as a disinfecting solution. In addition, Asgharian in column 12, lines 40-45 teaches that Part II disinfecting composition or part II composition refers to either a stand-alone disinfecting composition or a part II component of a multi-purpose composition. Therefore, such teaching indicates that the disinfecting composition can be a stand alone as a disinfecting solution without the enzyme solution. In conclusion: Asgharian et al. teach a two part composition having the enzyme solution in part I and the claimed components as disinfecting solution in part II. Asgharian et al. makes clear that even the mixture of such parts is physiologically acceptable to the eye. Asgharian also makes clear that the part II of the composition can be either a stand-alone disinfecting solution or a "part II" of a multipurpose composition. Therefore, the stand-alone disinfecting solution of Asgharian et al. does not include an enzymic solution.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Zohreh A Fay/

Primary Examiner, Art Unit 1627

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/Johann R. Richter/

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